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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,573	05/18/2004	Dimitri Chernyak	018158-024000US	6344
20350 7590 05/22/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3769				
MAIL DATE		DELIVERY MODE		
05/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/849,573

Applicant(s)

CHERNYAK, DIMITRI

Examiner

david shay

Art Unit

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 2, 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 2, 2009 has been entered.

The arguments set forth in the previous office action are hereby repeated and incorporated into the instant office action as if wholly set forth herein.

Applicant argues that the recitation in claim 32 is definite, because, when read in view of the specification as amended, the claim is understandable to one of ordinary skill in the art. The examiner must respectfully disagree. There is still no indication whatsoever as to the particular diameter of the pupil, a widely variable diameter structure, that the ablation area diameter is supposed to be scaled to. Adding a recitation to the specification that the diameter can be scaled, without any limitation or qualification of the diameter, which could vary from less than 3mm to greater than 7 mm a change of more than a factor of 2, is insufficient to render the recitation definite. If applicant believes that one of ordinary skill in the art would understand the diameter referred to in the claim, applicant is respectfully requested to submit publications detailing this. Such a submission would overcome the rejection.

With regard to the rejection of claim 1 et seq. under 35 U.S.C. 102, applicant argues that Largent discusses shaping different zones of a single eye, but does not teach or suggest "providing complimentary ablation shapes for first and second eyes". Applicant's arguments are not convincing because they are directed to limitations that do not exist in the claims, and in fact are not set forth in the originally filed disclosure. The originally filed disclosure is silent on

providing any sort of “complimentary ablation shapes for first and second eyes”. Further the claims are much broader. Claim 1 only requires that a central zone of the first eye be corrected in such a manner as to improve near vision, while the second eye has a peripheral zone ablated to improve near vision. There is no recitation of any limitation to the configuration of the central zone of the second eye or the peripheral zone of the first, thus any assertion of “complimentary ablation shapes for first and second eyes” is completely without merit, even if such were disclosed in the originally filed disclosure. As stated by applicant Largent discusses correcting the central zone of a farsighted eye for intermediate vision (see the instant response, page 10, third full paragraph, second sentence), this will necessarily “improve the patient’s ability to view near objects through the central zone of the first eye” as claimed in claim 1. Further, the provision of a near vision correction in a peripheral zone would clearly improve near vision in that peripheral zone. Thus, clearly, the instant claims would read on the method of Largent even if the same correction were applied to each eye. Thus applicant’s arguments are not convincing.

With regard to the combination rejection, applicant argues that McMillen et al do not teach a treatment table. The examiner must respectfully disagree. The instant disclosure describes the treatment table thusly: “The laser treatment table 14 includes a listing of coordinate references of the laser beam during an ablation of the cornea.” (see the originally filed disclosure, the paragraph bridging pages 10 and 11, fourth sentence). McMillen et al clearly disclose “an ophthalmological laser surgery system is provided with a patient data card read/write device for controlling and monitoring the operation of the laser surgical system in conjunction with a pre-coded patient data card. The data card and read/write device interact in such a manner that the laser surgical system cannot be operated unless an authorized patient data

card is inserted into the read/write device. Once the patient data card is recognized by the system as a legitimate and authorized card, the system is unlocked for normal operation. Preferably, during normal operation the beam delivery parameters calculated by the system, as well as other actual surgical operation data (such as the configuration of the delivery system optics, the duration and power of the laser irradiation of the patient's cornea, the coordinates of the projected laser beam, and the like) are recorded on the patient data card" (see column 2, lines 34-50). Thus this argument is not convincing.

The amendment filed February 2, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "determining a complimentary treatment plan".

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 42 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on "a complimentary treatment plan".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 is further indefinite, as it is unclear how the diameter of the central ablation zone can be scaled to that of the pupil, which has a variable diameter depending on lighting conditions. Claim 42 is indefinite, as the term “complementary treatment plan” lacks positive antecedent basis in the originally filed disclosure and thus the meaning thereof is unclear.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 9, 11, 14-17, 19, 23, 24, 26, 41, and 42 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Largent.

Largent teaches providing concentric ablation areas of both far and near vision corrections in each eye, thus providing the claimed peripheral curvatures, and providing a mid range aspherical ablation which will increase the distance vision in a near sighted eye and the near vision in a far sighted eye; the diameter of the central zone will have some numerical relationship to one of the many diameters the pupil can assume and can therefore be considered “scaled” thereto by the factor of the numerical relationship; and the near vision in a far sighted eye, and as can be seen from the power graph in Figure 3, also provides the claimed transition

zones.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6-8, 10, 12, 13, 18, 20-22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent. Largent provides the teachings set forth above. It would have been obvious to the artisan of ordinary skill to provide an unablated zone in the central region and the specific diopter corrections recited, since these are well within the scope of one having ordinary skill in the art, are not critical, and provide no unexpected result, thus producing a device and method such as claimed.

Claims 27-30, 32, 36, 37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with McMillen et al. Largent provides the teachings set forth above. McMillen et al teach employing a tangible medium to instruct a processor to control an optical system to cause a laser to ablate an eye according to a treatment table. It would have been obvious to the artisan of ordinary skill to employ the medium and treatment table of McMillen et al in the device of Largent, because Largent doesn't provide any details regarding the laser scanning system to recurve the eye, thus one of ordinary skill in the art would of necessity look to the laser cornea recurving art to determine the form such a system would take, thus producing a system such as claimed.

Claims 31, 33-35, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with McMillen et al. Largent and McMillen et al provide the teachings

set forth above. It would have been obvious to the artisan of ordinary skill to provide an unablated zone in the central region and the specific diopter corrections recited, since these are well within the scope of one having ordinary skill in the art, are not critical, and provide no unexpected result, thus producing a device and method such as claimed.

Applicant's arguments filed February 2, 2009 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/

Primary Examiner, Art Unit 3769